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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte CARL M. HOFFMASTER, DAVID K. TRUAX,
11 and TIMOTHY P. BEATON
12

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14 Appeal 2007-3648
15 Application 09/924,961
16 Technology Center 3600
17

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19 Oral Hearing Held: April 10, 2008
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23 Before LINDA E. HORNER, DAVID B. WALKER, and BIBHU R.
24 MOHANTY, Administrative Patent Judges
25

26 ON BEHALF OF THE APPELLANT:
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36 The above-entitled matter came on for hearing on April 10, 2007, at the U.S.
37 Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia,
38 before Dan Hawkins, Free State Reporting, Inc.

PROCEEDINGS

JUDGE HORNER: Are you ready?

MR. HUDDLESTON: Thank you. May it please the Court, I'm now here to present the Appeal 2007-3648 for Serial Number 08/924,961. This application is related to the application previously discussed in that this is a restricted claim. Eight claims are pending with one being independent. Through examination, the Examiner held that Independent Claim 132 was anticipated by a Magarian (phonetic sp.) reference, and furthermore, that the same Independent Claim 132 was obvious in view of the same Magarian reference in view of a further reference by Mr. Graham Mensa Wilmot (phonetic sp.). Because all remaining claims are dependent and are directed to -- are dependent upon Independent Claim 132, we'll direct our attention to that claim only for this argument.

Referring to Claim 132, in it's current state, it is directed toward an expandable reaming tool having at least two reamer pads coupled to the tool body and adapted and disposed between retracted and expanded positions, having at least one blade on each reamer pad, having a plurality of cutting elements on the blades wherein selected cutting elements disposed on the at least two reamer pads are positioned to contact a well borer at a substantially same axial location as other selected cutting elements to form a redundant cutting arrangement.

In particular, as described before in reference to the former Appeal, it is our position that the Magarian reference as proposed by the Examiner does not have the pad, blade and cutting element structure as required by the claim.

1 As described before, the pad structure, the pad blade cutting element
2 structure allows for blade, blade standoff. If you refer to the Application at
3 Paragraph 44, it improves cutting transport, fluid circulation and cooling.
4 Furthermore, we note that the redundant cutting structure is not available in
5 Magarian as the plurality of cutters show a single cutter. Magarian shows a
6 mere single cutter instead of a plurality of cutters as has a wear resistant
7 member.

8 JUDGE MOHANTY: Well, doesn't the blade that follows that isn't
9 that the redundant cutter in this? They come in pairs if you look at Figure 1,
10 you have 5a and 5b. So, 5a is one cutter wouldn't 5b be the other one; the
11 redundant cutter that comes right after?

12 MR. HUDDLESTON: In this case, the cutter, the cutting elements
13 are, it's a plurality of cutting elements on each blade. So, in this case, we
14 have one cutting, we have a cutting surface and a following cutting surface.
15 It's --

16 JUDGE MOHANTY: Isn't that Figure 8 for this reference? It's got
17 a blade, 54, another blade, 54 right after it?

18 MR. HUDDLESTON: I'm sorry, Your Honor, which, which one are
19 you referring to on Figure 8?

20 JUDGE MOHANTY: Figure 8.

21 MR. HUDDLESTON: Oh, those, those are inserts. Those Items 54,
22 58 are hard metal inserts. They're not cutting --

23 JUDGE MOHANTY: The specification --

24 MR. HUDDLESTON: -- elements.

25 JUDGE MOHANTY: -- the, the patent describes them as cutting at
26 three points. Column 66, it says the bar to allow material moved by the bars

1 to be cleared from cutting faces of the bar. The bars refers to Element 54.
2 He also refers to that twice in Element 7 where he talks about raised cutting
3 surfaces and the inserts on Gauge D to provide an optimum cutting action,
4 and Surface B being shown in Figure 6.

5 MR. HUDDLESTON: That is open for interpretation; however, we
6 do we, we, we prefer to focus on the, on the lack of the pad and cutting
7 blade. The pad blade structure --

8 JUDGE MOHANTY: Okay.

9 MR. HUDDLESTON: -- as a primary difference. There are no pads
10 on Item 2c. Furthermore, the Examiner undermines his own argument in
11 further rejecting under 103 using a combination of the Magarian reference
12 with the Mensa Wilmot reference. When he says it would have been
13 obvious, excuse me -- in, in forming the 103 objection, rejection the
14 Examiner makes a statement that the Magarian reference shows all of the
15 features of the present application except for the redundant cutting structure,
16 and then proffers the, the Mensa Wilmot reference to show the redundant
17 cutting structure.

18 Our objection to the combination of Mensa Wilmot with Magarian is
19 rooted in an non-combinable reference argument. In particular, Mensa
20 Wilmot is directed towards drill bits, and the present application is directed
21 towards a reamer.

22 In support of this proposition, in support of this position we proffered
23 the Declaration of a Mr. Graham Mensa Wilmot who not is, is actually the
24 primary inventor on the patent being cited. In Paragraph 10 of his
25 Declaration and he states, "It is known in the art that successful cutting
26 element arrangements for drill bits may not be successful for under-reamers

1 and vice versa. This is due to the different roles of drill bits and under-
2 reamers. Drill bits must create a hole while under-reamers expand a
3 previously drilled hole. In general, when designing drill bits or under-
4 reamers, one of ordinary skill in the art would not look to the teachings of
5 those in these art areas in order to solve a problem with another. Thus, one
6 of ordinary skill in the art would not be motivated to combine the disclosure
7 of Magarian with the disclosure of Mensa Wilmot.”

8 Therefore, all we have in this case we have evidence from one
9 certainly of ordinary skill in the art in bit design at the very least that --

10 JUDGE MOHANTY: Okay, your, your evidence is really opinion
11 evidence, though. It's his opinion. It's not a factual statement. It's his
12 opinion. The primary consideration, obviousness is a *prima facie* case itself
13 that the 132 Declaration is secondary consideration and your filing of that
14 132 Declaration, you know, is not enough to, to -- it has to overcome the
15 *prima facie* case. Why wouldn't someone who's looking at a reamer, why
16 wouldn't they look at a drill bit. They're both cutting tools in the oil
17 industry. And, it appears in this industry, they're actually attached to each
18 other in a tool. So, why wouldn't that be something that you could easily
19 look to as inter-related to each other?

20 MR. HUDDLESTON: I, I believe that those, those in the, you know,
21 the business of designing these tools specifically, you know, including the
22 Declarant, Mr. Wilmot himself know that the types of things that are used to
23 design the bits don't always work. They're not, they're, they're
24 knowledgeable in that they don't always work together in the same way.
25 Certainly, you know, certainly the, the, the under-reamer is a close follower

1 of the drill-bit in terms of proximity on the drill string itself. They work
2 together frequently.

3 JUDGE MOHANTY: Well, I mean, why would you even have to
4 look to a drill bit? I mean, wouldn't it just be common sense if you want to
5 cut something again, you just have another blade behind it; like a lawn
6 mower or razor blade where they stack the razor blades. Every time I turn
7 on the TV they got stack razor blades. I mean, that's, to me the *prima facie*
8 case. These reamers are as they're shown in the first reference and just use
9 this to back it up.

10 MR. HUDDLESTON: Well, in that, in that case there has been a lot
11 development in the, in the reamer, in the cutting structure design for drill bits
12 and reamers alike.

13 JUDGE MOHANTY: I just want to -- this Mensa Wilmot, he's also
14 an employee of the company; right?

15 MR. HUDDLESTON: I'm not certain if --

16 JUDGE MOHANTY: (Indiscernible)

17 MR. HUDDLESTON: -- he is still an employee of the company.

18 JUDGE MOHANTY: Okay.

19 MR. HUDDLESTON: The patents are commonly assigned.

20 JUDGE MOHANTY: Okay, when he says I'm an employee of
21 Smith International.

22 MR. HUDDLESTON: To this day, I don't know if he's still --

23 JUDGE MOHANTY: Okay.

24 MR. HUDDLESTON: At the time of the Declaration, he was.

25 JUDGE MOHANTY: Okay, at the time of Declaration he was.

26 MR. HUDDLESTON: I'm not sure if he still is.

1 JUDGE HORNER: Can we go back to the argument about Magarian
2 not having pads? Why, why aren't these items in Figure 5 marked 6a and 6b
3 pads? What, what is your definition of pad that would distinguish these?
4 Because it seems like they've got a pad, a pad and then they've got this part
5 that goes around the parameter of it that would be maybe considered a blade,
6 and they've got the Element 55 which could be the cutting element.

7 MR. HUDDLESTON: You know, of course, pads are a term of art in
8 the oil field as well. Pads are generally wither stationary. They're, they're
9 permanently affixed or they're in the case, as with the case with the present
10 application, they're extendable and out of the body. The pads provide a
11 mounting location, if you will, for the blades themselves. They are
12 structural supports that allow for clearance to facilitate cleaning and
13 performance of the cutting as well, and cooling of the, of the, of the elements
14 and the equipment below.

15 6b is a cutter blade. It is as would be known by one of ordinary skill
16 in the petroleum exploration arts. 6a and 6b would be blades and I think
17 what you're direction your attention to the area drawn around the periphery -
18 -

19 JUDGE HORNER: Um-hum.

20 MR. HUDDLESTON: -- would be analogous to a cutting element.
21 As such, there are no, no blades shown. If we refer to, refer to Figure 5a and
22 5b of the present application, you'll note the distinction where Items 62 are
23 pads and Items 60 are blades. The pad, looking at the top of Figure 5a, Pad
24 62a is a protrusion from the tool body, 61, providing for a channel, if you
25 will, between adjacent pads, 62b and 62a for fluid flow enabling all the other

1 benefits that were described earlier; the cooling, the cutting's removal,
2 etcetera.

3 JUDGE HORNER: DO you have any evidence in the record that pad
4 is a term of art?

5 MR. HUDDLESTON: Only at Paragraph 44, the specification,
6 where it talks about the blade standoff benefits. Talking about the distance
7 typically referred to as blade standoff clearance before and after surface, the
8 reamer pad that standoff in Figure 4 of these two cutting elements.

9 Accordingly, cutting transport is improved and improved during fluid
10 circulation also improves cutting element cooling.

11 JUDGE HORNER: Okay.

12 MR. HUDDLESTON: In response to Your Honor's comment about
13 the, the mere opinion evidence of, of the, the Mensa Wilmot Declaration and
14 its, its suitability for determining factual basis. We note that the Examiner is
15 basing his, using his own opinion to form the rejection itself. You know,
16 under, under recent guidelines, you know, it issued by the United States
17 Patent Office through the Federal Register back in October, the examiners
18 must provide explanation clearly supporting rejection and finding facts in
19 rationality for rejection. Seven rationales were suggested. It is believed that
20 the one most applicable, since the Examiner stated it would have been
21 obvious at the time of invention to provide Magarian with redundant cutters
22 of Mensa that wither rationale C, use of known techniques to improve
23 similar devices in the same way or rationale E obvious to try are the two
24 most likely to fit the rejection, especially since the rejection was made
25 before the KSR case and the subsequent rules were handed out.

1 However, we note that in the same guidelines, we note that the in
2 response to the use of known technique to improve similar devices, the
3 Examiner must find it would have been predictable to one of ordinary skill
4 in the art. In response to the obvious to try rationale, the guidelines also
5 provide that the Examiner must find reasonable expectation of success. In
6 response to that we have a Declaration from certainly one of ordinary skill in
7 the, the drill bit arts of designing that it is not predictable, and, that it is not a
8 reasonable expectation of success.

9 JUDGE MOHANTY: He doesn't, he doesn't say that it's not
10 predictable; does he? I can't see how it wouldn't be predictable that if you
11 used multiple blades you wouldn't cut more material.

12 MR. HUDDLESTON: Well, that's true, Your Honor, that he does
13 not use the word unpredictable, he, he does say that success in the drill-bit
14 sense is not equal, equate to success in the reamer.

15 JUDGE MOHANTY: But, regardless, it's his opinion; right?

16 MR. HUDDLESTON: Of course.

17 JUDGE MOHANTY: Okay, alright.

18 MR. HUDDLESTON: Thus, the Examiner is merely proffering his
19 own opinion as a person having ordinary skill; however, we note that his
20 opinion as one of ordinary skill in the art occurs approximately at the very
21 least two years following the filing, so it's not necessarily the time the
22 invention was made. And, also he is skilled in examining not necessarily in
23 designing these pieces himself. Therefore, we believe it's evidence of hind-
24 site reconstruction.

25 In summary, it is our opinion that, and belief that the Magarian
26 reference does not include the pad, blade, cutting element structure required

1 in Claim 132. And, then in response to the Examiner's supplemental
2 rejection under 103 that in combination with one Mensa Wilmot, that it does
3 meet the requirements of Claim 132. we respectfully traverse on the basis
4 that the references are not properly combinable, and that the case should be
5 allowed as written.

6 JUDGE HORNER: Any other questions?

7 JUDGE MOHANTY: No, thank you.

8 JUDGE HORNER: Okay.

9 JUDGE MOHANTY: Thank you.

10 JUDGE HORNER: Thank you.

11 MR. HUDDLESTON: Thanks.

12 (Whereupon, the proceedings concluded.)